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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,363	09/28/2005	Earl C. Downey	01630-21317.PCT.US	3075
20551 7590 05/27/2009 THORPE NORTH & WESTERN, LLP. P.O. Box 1219 SANDY, UT 84091-1219				
EXAMINER				
HORNBERGER, JENNIFER LEA				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
05/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/551,363

**Applicant(s)**

DOWNEY, EARL C.

**Examiner**

JENNIFER L. HORNBERGER

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/309)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/13/2009 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

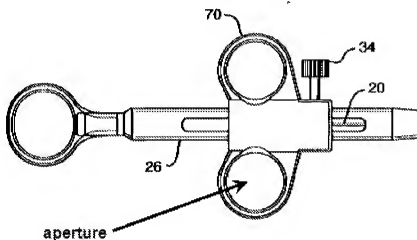
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 5, 9-12, and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (US 6,074,408).

Regarding claims 1, 2, and 12, Freeman discloses a surgical device, comprising: an ergonomic handle (16) having an aperture (see figure below) accessible and operable by a single finger of a user; a finger actuator (inner surface of the ring) accessible through the aperture, the finger actuator being sized and shaped to receive the finger of the user, the finger actuator comprising a finger receiving portion operable with a translating shaft; an elongated tubular portion (18) extending from the ergonomic handle and having a longitudinal axis; and a rod (20) functionally disposed within the tubular portion along the longitudinal axis, the rod being coupled proximally to the translating shaft of the finger actuator and configured to be coupled distally to a functional end (22), wherein the finger actuator moves in a non-pivoting, linear manner to directly effectuate an equidistant linear movement of the rod while maintaining a

hand of the user in a functional position about the ergonomic handle, a functional end (22; Fig. 2A-2F) coupled to a distal end of the rod, such that bidirectional pressure applied by the single finger to the finger actuator along the longitudinal axis manipulates the functional end in a bidirectional manner in a common direction to the bidirectional pressure (col. 5, ln. 10-40; col. 7, ln. 38-42).



Regarding claims 5 and 15, Freeman discloses the elongated tubular portion is detachable from the ergonomic handle (col. 5, ln. 20-23).

Regarding claims 9-11 and 16-18, Freeman discloses the functional end is selected from the group consisting of a grasper, scissors, a blade, a laser and a needle holder (Fig. 2A-2F; col. 6, ln. 6-30).

Regarding claim 19, Freeman discloses a method of manipulating a surgical instrument with a single finger, comprising the following steps: grasping the surgical instrument with a hand of a user; inserting the single finger of the user into a finger actuator accessible through an aperture (see figure above) of an ergonomic handle of the surgical instrument; moving the single finger in a direction away from the hand, causing the finger actuator to move in a non-pivoting, linear manner away from the hand to directly effectuate operation of a functional end

(22) while continually maintaining a hand of the user in functional position about the ergonomic handle; and moving the single finger in a direction toward the hand, causing the finger actuator to move in a non-pivoting, linear manner toward the hand to directly effectuate operation of the functional end while further continually maintaining the hand of the user in the functional position about the ergonomic handle (col. 5, ln. 10-40).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 6,074,408) in view of Komiya (US 4,043,323). Freeman fails to disclose a ratcheting mechanism to lock the finger actuator in a fixed position, thus locking the functional end in a fixed position. Komiya disclose a ratcheting mechanism to lock a finger actuator (23) in a fixed position, thus locking the forceps (17) in a fixed position (col. 3, ln. 26-41). It would have been obvious to one of ordinary skill in the art to modify the device of Freeman to include a ratcheting mechanism in order to lock the functional end in a fixed position without the operator having to maintain the position of the finger actuator.

6. Claims 4, 14, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 6,074,408) in view of Rydell et al. (US 5,258,006). Freeman fails to disclose the functional end is free to rotate around the longitudinal axis or the step of rotating the functional end. Rydell et al. discloses a rotatable knob (3) for rotating forceps (12) about a longitudinal axis. It would have been obvious to one of ordinary skill in the art to modify the device of

Freeman to provide a rotatable knob (or rotulator) and to rotate the knob in order to change the orientation forceps or grasping members about the longitudinal axis.

7. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 6,074,408) in view of Polk et al. (US 4,226,239).

Regarding claim 6, Freeman fails to disclose the ergonomic handle has a shape of a pistol grip. However, Polk discloses the medical device having a grasping device which is actuated by a push-pull trigger member of the handle (Fig. 4-5). Polk discloses the stationary portion of the handle is a pistol grip (46). It would have been obvious to one of ordinary skill in the art to substitute the thumb ring of Freeman with a pistol grip since both features are well-known in the art for providing the stationary portion of push-pull actuation means. Substitution of one known element for another element providing the same function to yield predictable

Regarding claim 8, Freeman in view of Polk discloses a portion of the pistol grip that is substantially out of line with the longitudinal axis is detachable (col. 5, ln. 20-23).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 6,074,408) in view of Polk et al. (US 4,226,239) as applied to claim 6, and further in view of Cuschieri et al. (US 6,077,286).

Regarding claim 7, Freeman in view of Polk et al. fail to disclose the portion of the pistol grip that is substantially out of line with the longitudinal axis can be manipulated into a position that is substantially in line with the longitudinal axis. Cuschieri et al. discloses a portion of a pistol grip that is substantially out of line with the longitudinal axis and can be manipulated into a position that is substantially in line with the longitudinal axis. Cuschieri et al. discloses that the ability to adjust the handle position relative to the shaft of the instrument is ergonomically advantageous (col. 1, ln. 41-55 and col. 2, ln. 15-22). It would have been obvious to one of ordinary skill in the art to modify the device of Freeman as modified by Polk et al. to allow the

position of the portion of the pistol grip substantially out of line with the longitudinal axis of the instrument to be adjusted relative to the longitudinal axis as suggested by Cuschieri et al. in order to allow the operator to find the most comfortable hand position for operating the instrument.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER L. HORNBERGER whose telephone number is (571)270-3642. The examiner can normally be reached on Monday through Friday from 8am-5pm, Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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05/21/2009

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734